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JOHN M. HANCOCK

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In the Supreme Court of the United States

OCTOBER TERM, 1944

No. 469

SPECIAL EQUIPMENT COMPANY, PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT
OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR THE RESPONDENT

OPINIONS BELOW

The findings of fact and conclusions of law of the United States District Court for the District of Columbia (R. 9-11) were entered without an opinion. The opinions of the United States Court of Appeals for the District of Columbia (R. 142-152) are reported in 144 F. (2d) 497.

JURISDICTION

The judgment of the Court of Appeals was entered on June 19, 1944 (R. 153). A petition for rehearing (R. 153-158) was denied on July 18, 1944 (R. 163). The petition for a writ of

certiorari was filed on September 15, 1944, and was granted on November 6, 1944. The jurisdiction of this Court rests on Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTIONS PRESENTED

1. Whether the court below properly held the subcombination unpatentable because petitioner's purpose in seeking a patent on the subcombination was to exploit and protect the patent monopoly of the complete machine.

2. Whether, as the Patent Office and the District Court found, the subcombination claims here involved should be rejected because they were incomplete, misleading, and broader than the invention.

3. Whether in any event the subcombination claims should be rejected as not properly within the scope of the renewal application.

STATUTES INVOLVED

The relevant provisions of Sections 4884, 4886, 4888, 4897, and 4915 of the Revised Statutes and the Act of August 9, 1939, are set forth in the Appendix, *infra*, pp. 47-50.

STATEMENT

Petitioner's assignor applied for a patent in 1932 upon a fruit-treating apparatus which bobbed, split, pared, and cored pears for canning and other purposes. The apparatus is a machine

having two turrets, and operates as follows: The whole pear is introduced into one of the turrets, which rotates it past a bobbing device that cuts the top off. The fruit is then passed over a splitting knife which bisects it lengthwise. The two halves are then separated and transferred to the second turret where each half is separately peeled and cored (R. 9, 130-131). The application as filed contained claims covering the entire machine, and also a claim which covered all the features of the machine except the splitting knife. The latter claim was rejected by the Examiner and the Board of Appeals in the Patent Office as being "incomplete, misleading and broader than the invention" because it implied that the mechanism can peel whole pears, whereas the application disclosed a mechanism for peeling and coring half pears but not whole pears (R. 132).¹ The subcombination claim was thereupon cancelled and the other claims in the application were allowed in 1938 (R. 2, 124-125).²

¹The Patent Office files indicate that the applicant acquiesced in this rejection by cancelling the claim and took no steps to review the decision of the Board of Appeals either by way of appeal to the Court of Customs and Patent Appeals or by equity suit brought under R. S. § 4915. Paper No. 25, August 31, 1938, Ewald Application No. 636,447.

²To avoid the confusion into which petitioner appears to have fallen, the four-element machine (for which claims were allowed by the Patent Office), which bobs, splits, peels, and cores pears, is herein referred to as the entire or complete machine; the three-element machine (the claims to which are here in issue), which is identical with the four-element ma-

In 1939 petitioner's assignor renewed the application (R. 125). Four claims presented with the renewed application (Nos. 38, 39, 41, 44, R. 5-7) covered an automatic machine for bobbing, peeling, and coring pears but again made no mention of any cutting device for halving the pears before coring and peeling. The Examiner again rejected these claims as being "incomplete, misleading and broader than the invention" because they imply, contrary to the fact, that the machine "pares and cores whole fruit" (R. 131-132). The Board of Appeals affirmed, saying (R. 134-135):

Nowhere in the original specification or original claims covering the combination of the two turrets was there any indication given that the splitting means can be omitted. The entire disclosure relates to the preparation of the pears by starting with whole pears. The holding means on the first turret are so shaped that they fit whole pears and hold them firmly while they are being operated on. A number of parts are so shaped that they are specially adapted to handle or operate on whole pears. The timing of the parts is such that the cutter comes into operation at a certain time during the preparation of the

chine except for the absence of the splitting device, is herein referred to as the partial machine or subcombination. The confusion is exemplified by petitioner's use in one paragraph of its brief (pp. 37-38) of the phrase "main invention" to describe first the three-element subcombination and then the four-element machine.

pears in the machine. The parts in the second turret are intended and adapted for paring and coring split pears and could not be used for paring and coring whole pears. It seems to us that the pear-splitting mechanism is an essential part of the machine and the entire machine was constructed with a view of starting with whole pears and splitting them.

While conceding that "subcombination claims may be obtained in addition to claims to the entire combination," the Board of Appeals rejected this subcombination because the claims without a pear-splitting means covered a construction "never contemplated by applicant," there being "no indication that the construction claimed can or was ever intended to accomplish a result" (R. 135).

Petitioner's assignor then brought this suit in the United States District Court for the District of Columbia under Revised Statutes, section 4915 (35 U. S. C. § 63), to compel the Commissioner of Patents to issue a patent containing the four rejected claims (R. 2-5).³ After a trial, the district court dismissed the complaint (R. 11), finding as facts that "as disclosed in the application the bobbing means can act only on whole fruit and the paring and coring means only on half fruit"; that, as disclosed in the application, "the splitting

³ Petitioner was substituted as party plaintiff by order of the district court dated January 26, 1943 (R. 13-14).

knife is an essential element of the combination and without it the two turrets could not combine to produce any useful result"; that "because of the omission of this essential element the claims are incomplete"; and that they therefore do not properly define petitioner's invention as required by Revised Statutes, section 4888 (R. 9-10).

The court below affirmed the judgment of the district court (R. 153). Without deciding whether the ground of rejection in the district court was correct, the court below held that even if the subcombination claims "present a distinct and useful invention", a patent thereon must be denied because petitioner's purpose in making the claims thereon was not to use it or license others to use it, but "to exploit and protect the patent monopoly of another related invention, to wit: the complete machine" (R. 143).

SUMMARY OF ARGUMENT

Petitioner is seeking a decree that it "is entitled, according to law, to receive a patent" (R. S. § 4915, 35 U. S. C. § 63) covering its subcombination claims. We submit that petitioner was properly denied such a decree on the basis of any one of three independent grounds.

1. The subcombination claims were properly rejected because they were intended solely to protect and exploit the invention consisting of the entire machine. That this was petitioner's intention was found by the court below, whose con-

clusion in this regard is amply supported by the evidence.

The public purpose which the patent grant is intended to serve stems from the Constitution itself. The "Progress of Science and useful Arts" was the aim of those who drafted the Constitution; the "exclusive Right" secured to the inventor was but the means provided to accomplish that purpose. Congress early indicated such purpose could be served only by the use of inventions. Non-use and suppression, or, as here, suppression in the interest of a different patented invention were not included in the constitutional or congressional intent. Such practices run counter to the public purpose underlying the constitutional grant.

The decisions of this Court in *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U. S. 502, and the cases stemming therefrom hold that equity will not aid a patentee to enlarge the scope of his patent monopoly by means of "tie-in" license agreements or by using a patent to exploit a second patent monopoly not embraced in the first. These practices, inconsistent with the public interest, are similar to petitioner's proposed use of a patent on the subcombination to protect the patent on the main machine.

2. The district court upheld the rejection of the disputed claims by the Patent Office on the grounds that the splitting knife is an essential element of the combination, the machine without

it was not the invention disclosed in the application and, since the rejected claims do not accurately describe the invention, they are not a true subcombination. Such findings of the district court, particularly since they concur with those of the Patent Office, should not be set aside unless shown to be clearly wrong. Here they are amply supported by the record.

3. The subcombination claims were not included in the claims originally allowed by the Patent Office, but were ~~also~~ included by petitioner's assignor in the renewal application. Since such an application must, under the statute and Patent Office Rules, be limited to the same invention as was covered by the claims originally allowed, the subcombination claims were improperly included therein.

ARGUMENT

I

THE SUBCOMBINATION CLAIMS WERE PROPERLY DENIED
BECAUSE INTENDED SOLELY TO PROTECT AND EXPLOIT
A DIFFERENT INVENTION

The court below held that petitioner's "purpose in making a distinct patent claim on the subcombination is not to stimulate the commercial development or financial return from that patent," but "to exploit and protect the patent monopoly of another related invention, to wit: the complete machine." The court further found that "There is no intention to make or license others to make the partial machine * * *.

There is no rhyme or reason for manufacturing such a partial machine when there is available the complete machine which does the cutting mechanically". (R. 143.)

A. These conclusions are amply supported by the evidence. That it was petitioner's intention to patent the subcombination solely to protect its monopoly in the entire machine is to be gathered from the facts in the record as to the operation of the machine with the pear-splitting device and without it. While it is possible to operate the machine without the splitting device, and with a more efficient result than if no machine at all were used, it is highly improbable that any one—certainly no commercial operator—would ever want to do so. Doing so would require first cutting the pears in half, holding the halves together face to face, and carefully and accurately placing them together in the machine, a process requiring double the number of operators involved in using the full machine. (R. 20, 26, 27.) This procedure is so devious, involved, and uneconomical when compared with the operation of the entire machine (R. 18, 26) as to demonstrate the impracticability of using the machine without the splitting mechanism.

Petitioner's own witness testified that use of the machine minus the splitting device was "a disadvantageous method" of preparing pears for canning (R. 25), and this is borne out by the

history of the commercial use of petitioner's machine. Although this machine has been in use in canneries since 1931 (R. 15), it was not until 1941 or 1942 that pre-split pears were first put into it, and then this "was tried out" only at the suggestion of petitioner's attorney (R. 23-25).⁴ In its brief in the court below petitioner admitted (p. 17): "The claims in issue are sought purely to prevent appropriation of the * * * machine by the obvious expedient of eliminating the splitting mechanism." This admission was repeated by petitioner in its oral argument below (R. 149).

B. Having found that petitioner was seeking a patent on the subcombination merely to protect the patent monopoly of the entire machine, the court below held that under the decisions of this Court, particularly *Ethyl Gasoline Corp. v. United States*, 309 U. S. 436, such use of a patent would be improper and contrary to public policy. The court concluded that petitioner was not entitled to a decree compelling the issuance of a subcombination patent. We believe that ruling was correct.⁵

⁴ According to petitioner's witness Skog, "This was done on one Sunday—we did not want to publicize the fact too much—" (R. 20), and motion pictures, later introduced in evidence in the district court (Pl. Ex. 6), were taken of the operation.

⁵ It should be noted at the outset that while petitioner is seeking one patent, with separate claims, covering both the entire machine and the subcombination, the situation at bar

It is to be observed that the decision below does not rest solely on the intention of the applicant not to use the subcombination for the duration of the patent sought. The ground given, and the only one discussed in either the main opinion or the concurring opinion, was that the patent was sought and its nonuse planned exclusively to aid and protect the independent monopoly on the entire machine. The effect of the ruling below is a refusal to order the Patent Office to issue a subsidiary patent sought to protect the main patent. Since a court sitting in a suit under Rev. Stat. 4915 functions as a court of equity (*Butterworth v. Hoe*, 112 U. S. 50, 61), and since, as we shall show, the intended use (or nonuse)

is no different than if petitioner had sought a separate patent for each, or had been compelled to do so by a Patent Office requirement that a divisional application be filed. (See Rule 42, Rules of Practice in the U. S. Patent Office.) The claims covering the entire machine were held allowable by the Patent Office, and if the subcombination claims had been allowed, they would be included in the same patent. But letters patent are not regarded as a single and indivisible right. They may be valid as to one or more of their claims while invalid as to others. *Russell v. Place*, 94 U. S. 606, 609; *Altoona Theatres v. Tri-Ergon Corp.*, 294 U. S. 477, 487. Each claim may therefore be considered as setting forth a separate invention. *Leeds & Catlin v. Victor Talking Mach. Co.*, 213 U. S. 301; *Veneer Co. v. Grand Rapids Co.*, 227 Fed. 419 (C. C. A. 6). And "it is the claim that measures both the patented invention and the infringement thereof." *Fulton Co. v. Powers Regulator Co.*, 263 Fed. 578, 580 (C. C. A. 2). Hence, the subcombination claims may here be treated, as they were by the court below, as though, if allowed, they would result in a separate patent from that covering the entire machine.

of the subcombination patent finds no sanction in law or policy, we submit that no abuse of discretion is involved in the refusal of equitable aid to the applicant in the circumstances at bar.

“The patent is a privilege * * * which is conditioned by a public purpose.” *Mercoïd Corp. v. Mid-Continent Co.*, 320 U. S. 661, 666. The dominance of the “public purpose” underlying the patent grant springs from the Constitution itself, which provides that “The Congress shall have Power * * * To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries” (Art I, § 8, cl. 8). The constitutional objective and the congressional authority is “To promote the Progress of Science and useful Arts”—clearly a “public purpose.” The means to that end is “securing” an “exclusive Right” for “limited Times to Authors and Inventors.”

From the earliest congressional responses to the constitutional mandate, it was clear that “the Progress of Science and useful Arts” was the *desideratum*, and not the “exclusive Right” secured to the inventor. Thus, the earliest patent law, enacted by the first Congress in 1790, was entitled simply “An Act to promote the progress of useful Arts” (1 Stat. 109), as were the two major patent acts enacted thereafter (1 Stat. 318; 5 Stat. 117). And the first patent act granted the patent monopoly only for such arts, man-

factures, engines, machines, or devices as were "sufficiently useful and important" (1 Stat. 110). Moreover, "the sole and exclusive right and liberty" granted under the patent authorized by the 1790 Act emphasized use, since it covered the "making, constructing, using and vending to others to be used, the said invention or discovery." Use was the dominant thought.⁶ There was no hint that "the Progress of Science and useful Arts," the "public purpose" underlying the constitutional grant, could be served by nonuse or suppression in a nation just born and dependent in large measure upon the development of its industrial economy. There is no hint that the inventor's exclusive right to make, construct, use, and vend "to others to be used" was also a right of the inventor not to make, not to construct, not to use, not to vend, and at the same time to preclude all others from doing so, in any and all circumstances. Much less was there any hint that the constitutional or statutory purpose could be served by obtaining a patent in order to suppress the invention in the interest of a different patented invention.

⁶ Compare the situation where the question of priority of invention is involved. It does not suffice, as between two inventors, that one of them conceived the invention first unless it appears also that he has not abandoned his invention. *Gayler v. Wilder*, 10 How. 477, but has proceeded with diligence to reduce it to practice. *Marconi Wireless Co. v. United States*, 320 U. S. 1, 35.

Indeed, total nonuse and utter suppression may well have been a wholly foreign concept in the formative days of our economy, with our expanding frontier, steadily growing population, and virtually unlimited domestic demand for manufactures. The prospect that the inventor of a valuable device or process would deliberately enclose it within a government-protected wall, placing it beyond the reach of the public for a substantial period of years (14 years under the first act), with the intention not to make any use thereof himself and to prevent anyone else from doing so, could scarcely have been seriously entertained. The theoretical right of the public to use the invention after the patent had expired could hardly have been regarded as a sufficient consideration for Governmental protection of a right to bottle up an important discovery for 14 years and thus prevent any other member of the public from arriving at the same result independently. For the grant of such a power to patent owners would obviously halt rather than promote the progress of science and the arts.

Congress has never swerved from the theory of the patent grant thus enunciated by the Constitution and effectuated by the First Congress. The patent laws of today provide for the issuance of a patent to "Any person who has invented or discovered any new and *useful* art, machine, manufacture, or composition of matter, or any new and *useful* improvements thereof" (R. S. § 4886, 35

U. S. C. § 31), and that such patent shall contain a grant to the patentee "of the exclusive right to make, *use*, and vend the invention or discovery" (R. S. § 4884, 35 U. S. C. § 40). [*Italics supplied.*]

In *Pennoek v. Dialogue*, 2 Pet. 1 (1829), in a case arising under the patent act of February 21, 1793 (1 Stat. 318), Mr. Justice Story, speaking for this Court, said (at 19): "While one great object [of the patent grant] was, by holding out a reasonable reward to inventors, and giving them an exclusive right to their inventions for a limited period, to stimulate the efforts of genius; the main object was 'to promote the progress of science and useful arts.'" Thirty years later this Court spoke again to the same effect. In *Kendall v. Winsor*, 21 How. 322 (1858), it said (at 327-328): "It is undeniably true, that the limited and temporary monopoly granted to inventors was never designed for their exclusive profit or advantage; the benefit to the public or community at large was another and doubtless the primary object in granting and securing that monopoly." And in *Seymour v. Osborne*, 11 Wall. 516 (1870), this Court said (at 533-534):

Letters patent are not to be regarded as monopolies, created by the executive au-

⁷ For prominence of the "use" concept in patent acts intervening the first patent act and today's statutes, see § 1 of the Act of February 21, 1793, 1 Stat. 318, §§ 5 and 6 of the Act of July 4, 1836, 5 Stat. 117, and §§ 22 and 24 of the Act of July 8, 1870, 16 Stat. 198.

thority at the expense and to the prejudice of all the community except the persons therein named as patentees, but as public franchises granted to the inventors of new and useful improvements for the purpose of securing to them, as such inventors, for the limited term therein mentioned, the exclusive right and liberty to make and use and vend to others to be used their own inventions, as tending to promote the progress of science and the useful arts, and as matter of compensation to the inventors for their labor, toil, and expense in making the inventions, and reducing the same to practice for the public benefit, as contemplated by the Constitution and sanctioned by the laws of Congress.

These early declarations by this Court, stressing the public purpose which patents were meant to serve and subordinating thereto "exclusive profit or advantage" of the patentee, pointed to the obvious corollary that patents which were not used did not serve that public purpose. At least that corollary was obvious to the Circuit Court for the Northern District of Illinois in *Hoe v. Knap*, 27 Fed. 204 (1886). In that case an injunction was refused in an infringement suit brought by the owner of a patent who had not, "after a reasonable time, put it into use," against one who was using it. Judge Blodgett stated that "under a patent which gives a patentee a monopoly, he is bound either to use the patent himself or allow

others to use it on reasonable or equitable terms." 27 Fed. 204, 212. The patent statute then in effect (Rev. Stat. 4886, 35 U. S. C. 31) was similar to its prototype in requiring that a patentable invention be "useful."

The Sixth Circuit Court of Appeals did not agree with this proposition, however. In *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288 (1896), which came to be the leading case in the lower federal courts on this point, that court upheld the right of a patentee to sell its patented machines subject to the "condition" that they be used only with unpatented articles (fasteners) made by the patent owner, to whom the title to the machine would immediately revert upon violation of the condition; and the court enjoined "contributory infringement" of the patent by defendants who sold unpatented fasteners of their own manufacture to persons using the plaintiff's machinery. Some 21 years later this Court was to renounce this ruling categorically, and to deny the patentee's right thus to extend his monopoly (*Motion Picture Patents Co. v. Universal Film Co.*, 243 U. S. 502; see also *Carbice Corp. v. American Patents Corp.*, 283 U. S. 27). But in expounding the basis for its now discredited ruling, the Sixth Circuit Court of Appeals posited an even broader right of the patentee—not to use or permit use at all—from which, it felt, stemmed the lesser right to impose conditions as to the use of unpatented materials in connection

with the patented invention. The court stated: "If he [the patentee] will neither use his device, nor permit others to use it, he has but suppressed his own * * *. His title is exclusive, and so clearly within the constitutional provisions in respect of private property that he is neither bound to use his discovery himself, nor permit others to use it." (77 Fed. 288, 294-295.) The court found nothing in such a right which "infringed" the "public policy" considerations, and thought that the patentee's conditional "licenses" were "within the privileges awarded by the patents" (77 Fed. 288, 301).

Upon the postulates of that case appears to have been founded the decision in the *Paper Bag Patent Case* (*Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405), where the nonuse of a patent was held insufficient, in the circumstances of that case, to oust the jurisdiction of a court of equity in a suit brought by the patentee to enjoin the infringement of that patent. In that case, petitioner asserts, exists support for its argument that its intention not to use the patent on the subcombination should not disentitle it to the issuance of the patent. But the instant case does not involve mere nonuse of a patent, it involves a patent sought solely for the purpose of exploiting another patent. The *Paper Bag* opinion (210 U. S., at 428-429) discloses that the patentee failed to construct machines under the patent because it was more profitable to continue

using the existing machine, "when the cost of building [new ones] was taken into account".

With respect to this the Court stated,

* * * it is certainly disputable that the non-use was unreasonable or that the rights of the public were involved. There was no question of a diminished supply or of increase of prices, and can it be said, as a matter of law, that a non-use was unreasonable which had for its motive the saving of the expense that would have been involved by changing the equipment of a factory from one set of machines to another?

The Court was obviously concerned with whether a patentee was to be under an obligation to develop the invention even though it was unprofitable for him to do so. The decision was merely that in these circumstances of that case the nonuse was not unreasonable as a matter of law. Indeed, the Court expressly reserved the question whether "a case cannot arise where, regarding the situation of the parties in view of the public interest, a court of equity might be justified in withholding relief by injunction" (210 U. S., at 430). The Court suggested two examples of unreasonable nonuse by pointing out that in that case "there was no question of a diminished supply or of increase of prices" (at p. 429). Later decisions of this Court make it clear, however, that these do not exhaust the types of abuse of a patent. As we show herein (pp. 21-24), the patent laws do not

permit the use of the monopoly to exploit or protect other unpatented or even patented interests.

In the *Paper Bag* case it did not appear that the intention of the patentee in taking out the patent was to suppress it for the protection of the older machinery, and the Court did not discuss the case from that point of view. Failure to use for reasons of economy may differ from nonuse for the deliberate purpose of exploiting another invention, the situation here. Indeed, to read the case as sustaining the right of a patentee to equitable relief in the latter circumstance would bring it into conflict with the doctrine which this Court has since repeatedly applied that equity will not aid a patentee who is using his patent for the purpose of protecting something outside of its monopoly.

It is our view, moreover, that the objective of the Constitution and of the patent laws would equally warrant denying equitable aid to a patent owner who prevents the use of his invention in order to preclude experimentation by others which might result in further invention that would compete with his business. For while in the *Paper Bag* case the plaintiff was not shown to have obtained the patent in suit for the purpose of aiding his other patents, the reason why he did not use the infringed patent was because his interests were better served by continuing to use the other patents. See 210 U. S. at 428-429. In *Ethyl Gasoline Corp. v. United*

States, 309 U. S. 436, this Court held that the patent monopoly does not permit the patent to be used in order to exploit another patent owned by the same person (see p. 24, *infra*). We suggest that this more recent decision seriously undermines the authority of the *Paper Bag* case, inasmuch as it should make no difference whether the object of a use or nonuse is to protect another patent, to control an unpatented commodity, or merely to further one's economic interests generally.

In this case, however, the "nonuse" which petitioner had in mind when applying for the subcombination patent was, as already pointed out, intended to aid the patent on the entire machine. In other terms, the subcombination patent was to be used to protect, not the invention described therein, but a different patented invention. That type of use falls within the line of decisions in which, starting in 1917, this Court has prohibited the extension of the patent monopoly beyond its legitimate subject matter—the invention described in the patent.

In *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U. S. 502 (1917), this Court first held that the situation of the parties in view of the public interest may justify a court of equity in withholding relief by injunction from a patent owner. There a patent owner required purchasers and lessees of its patented motion picture machines to use

therewith only unpatented articles controlled by the patent owner (motion picture film). Such a requirement had been approved only 5 years before by this Court in *Henry v. Dick Co.*, 224 U. S. 1, in reliance upon the *Button-Fastener* case, which had approved *obiter* the patentee's right to suppress his invention. But in the *Motion Picture Patents* case, this Court expressly overruled *Henry v. Dick Co.*, and necessarily its predecessor, the *Button-Fastener* case, and denied equitable relief to the patent owner against a "contributory infringer" who sold unpatented film for use with the plaintiff's invention. The guiding principle was "that the scope of the grant which may be made to an inventor in a patent, pursuant to the statute, must be limited to the invention" (243 U. S., at 511) and may not be extended to "the materials with which or on which the machine operates" (243 U. S., at 512).

An unbroken line of judicial decisions⁶ stems from the *Motion Picture Patents* case clearly limiting the patentee's privileges to making, using, and selling the patented invention, as provided in the statute. See R. S. § 4884, 35 U. S. C. § 40. The principle that a patentee may not enlarge the scope of his patent monopoly by tying to the use of the patented device or process the use of other devices, processes, or materials, has been applied to deny equitable relief against the disobedient licensee or those contributing to his disregard of the "tie-in" condition (*Carbice Corp.*

v. *American Patents Corp.*, 283 U. S. 27; *Leitch Mfg. Co. v. Barber Co.*, 302 U. S. 458). It has also been held to render the hands of the patent owner so "unclean" as to require denial of equitable relief against an infringer of the main patented device itself, at least until the effects of the misuse through the "tie-in" practices have been dissipated. *Morton Salt Co. v. Suppiger Co.*, 314 U. S. 488; *B. B. Chemical Co. v. Ellis*, 314 U. S. 495; *Mercoid Corp. v. Mid-Continent Co.*, 320 U. S. 661; *Mercoid Corp. v. Honeywell Co.*, 320 U. S. 680; cf. *United Shoe Machinery Corp. v. United States*, 258 U. S. 451, 462-464; *International Business Machine Corp. v. United States*, 298 U. S. 131, 140.

But the public policy which confines the patent grant to the exclusive right to make, use and sell the invention, is not restricted to the attempted projection of the monopoly into unpatented fields. It is as fully a misuse for the patentee to seek to extend the effects of his monopoly to the subject matter of another patent owned by him, and this Court has accordingly held that the owner may not use his patent to exploit a second patent monopoly not embraced in the first. *Ethyl Gasoline Corp. v. United States*, 309 U. S. 436; cf. *Hartford-Empire Co. v. United States*, Nos. 2-11, this Term, decided January 8, 1945. In the *Ethyl Gasoline* case the defendant in an antitrust prosecution owned several

patents relating to an anti-knock motor-fuel. One was for tetra-ethyl lead; another covered the mixture of that and gasoline. The defendant's revenue came from the sale of the tetra-ethyl; the mixture patent was used to aid the exploitation of the tetra-ethyl patent. This Court disapproved such use of the mixture patent, saying (309 U. S. at 459):

* * * The patent monopoly of one invention may no more be enlarged for the exploitation of a monopoly of another, see *Standard Sanitary Mfg. Co. v. United States*, *supra*, than for the exploitation of an unpatented article, *United Shoe Machinery Co. v. United States*, *supra*; *Carbice Corporation v. American Patents Corp.*, *supra*; *Leitch Manufacturing Co. v. Barber Co.*, *supra*; *American Lecithin Co. v. Warfield Co.*, 105 F. (2d) 207, or for the exploitation or promotion of a business not embraced within the patent. *Interstate Circuit v. United States*, *supra*, 228-230.

In the instant case petitioner seeks to accomplish, in effect, what was held to be improper in the *Ethyl Gasoline* case. It seeks to use "the patent monopoly of one invention"—the subcombination—"for the exploitation of a monopoly of another"—the patent on the complete machine. This would extend petitioner's patent monopoly as fully beyond the statutory grant as this Court found to be true in the *Ethyl Gasoline* case. And, shortly after

the latter decision, this Court observed that "In construing and applying the patent law so as to give effect to the public policy which limits the granted monopoly strictly to the terms of the statutory grant, * * * the particular form or method by which the monopoly is sought to be extended is immaterial." *United States v. Univis Lens Co., Inc.*, 316 U. S. 241, 251-252.⁸

We do not read the decision of this Court in *Hartford-Empire Co. v. United States*, Nos. 2-11, decided January 8, 1945, as weakening the authority of this long line of cases holding that a patentee who has used a patent for the exploitation of something outside its monopoly cannot obtain the aid of a court of equity. The *Hartford* case held that in an antitrust suit the Government was entitled to enjoin any "cooperative effort" by the defendants to take out patents in order "to prevent others from obtaining patents on improvements which might, to some extent, limit the return in the way of royalty on original or fundamental inventions" (slipsheet pp. 32-33), but that the Government could not obtain a similar injunction against each

⁸ This Court has also held that a patentee may not use his patent monopoly so as to control resale prices by the purchaser of the patented article. *Bauer & Cie v. O'Donnell*, 229 U. S. 1; *Straus v. Victor Talking Machine Co.*, 243 U. S. 450; *Boston Store v. American Graphophone Co.*, 246 U. S. 8; Cf. *Adams v. Burke*, 17 Wall. 453; *Bobbs-Merrill Co. v. Straus*, 210 U. S. 339; *United States v. General Electric Co.*, 272 U. S. 476, 485.

defendant individually applying for patents which it did not intend to use (pp. 33-34). The latter was held not to be an appropriate remedial provision in an antitrust decree. The considerations which guided the Court to its decisions in *Morton Salt Co. v. Suppiger Co.*, 314 U. S. 488, and *B. B. Chemical Co. v. Ellis*, 314 U. S. 495, were held not necessarily determinative of the relief the Government may obtain in a Sherman Act injunction suit. "Those cases," the Court said, at p. 20 of the slipsheet opinion, "merely apply the doctrine that, so long as the patent owner is using his patent in violation of the antitrust laws, he cannot restrain infringement of it by others. We were not there concerned with the problem whether, when a violation of the antitrust laws was to be restrained and discontinued, the court could, as part of the relief, forfeit the patents of those who had been guilty of the violation." Impelling public policy considerations, however, might properly constitute a bar to a patentee seeking affirmative relief in equity.

Furthermore, the *Hartford* opinion requires that all defendants' patents relating to the machinery in question be licensed in the future at reasonable royalties to all who wish licenses (slipsheet pp. 21, 23). This is designed to prevent suppression or nonuse of any of the defendants' patents. Thus although the *Hartford* decision refuses to enjoin a defendant from taking out a

patent with intention not to use it or permit its use, it makes other provision for insuring the availability of the patent to the public. The case can thus not be regarded as permitting a patentee to suppress his patent for an unlawful purpose when no such safeguard is established.

We do not argue that all nonuse of a patent is *ipso facto* contrary to public policy or counter to the constitutional and statutory purpose to promote the progress of the useful arts. The exploitation of a patent may be postponed, for example where capital for its development cannot be raised, and there may be other legitimate grounds for nonuse. The nonuse here involved, however, has no such legitimate basis. While such suppression as is here involved, without more, may not have vitally concerned the public interest in 1908, the situation is by no means the same in 1945.

Since the decision in the *Paper Bag Patent Case* almost 4 decades ago, much has been learned concerning the use, nonuse, and suppression of patents to build and maintain monopolies, to commit and perpetuate improper trade practices, to wage business warfare, and to exert economic control far beyond the scope of the patent grant. Compare, for example, *Henry v. Dick Co.*, 224 U. S. 1, with *Ethyl Gasoline Corp. v. United States*, 309 U. S. 436. These improper practices

are not always aimed simply at securing "diminished supply" or an "increase of prices." They may involve complicated systems, based essentially upon patents, designed to bring under control all aspects of an entire industry. Cf., *e. g.*, *Hartford-Empire Co. v. United States*, *supra*, modifying and affirming 46 F. Supp. 541 (N. D. Ohio); *Ethyl Gasoline Corp. v. United States*, *supra*; *United Shoe Machinery Corp. v. United States*, *supra*. They may involve suppression even where use of the patent is important to protect the health of great numbers of the public. Cf. *Vitamin Technologists Inc. v. Wisconsin Alumni Research Foundation*, C. C. A. 9, November 24, 1944.⁹

The practice of patent suppression acquires geometrically increased importance with the current trend toward concentration of the ownership of numerous patents in a given field.

It has become a commonplace for large manufacturers to amass large numbers of patents although in their operations they use but a few of them.

⁹ See also Hearings before the Committee on Patents (Bone Committee), United States Senate, 77th Cong., 2d Sess., Parts 1-9. Hearings before the Temporary National Economic Committee, Part 2, *Patents*, pp. 253-834; Part 5, *Development of the Beryllium Industry*, pp. 2011-2304; Part 15, *The Petroleum Industry*, pp. 8328-8330; Part 25, *Cartels*, pp. 13037-13583; Monograph No. 31, *Patents and Free Enterprise*.

It may be that only a few of the inventions are actually employed; the solid phalanx is terrifying to competitors and to upstarts who would trespass upon its market. * * * The imperium of the United Shoe Machinery Company is barricaded by some 6,000 patents. Du Pont, Hartford-Empire, R. C. A.-Victor have piled patent on patent to secure against invasion the whole range of their activities.

* * * * *

A mere 9 patents are employed in the construction of the ordinary electric lamp; less than 40 are called into play in producing the most complicated lighting apparatus. Yet General Electric grounds its licenses upon a recitation of more than 300 separate grants. Many inventions are accorded the imprimatur of the Patent Office, yet few are put to work. (Temporary National Economic Committee, Monograph No. 31, *Patents and Free Enterprise*, pp. 46-47, 59.)

The Hartford-Empire Company, referred to above, openly avowed its intention to use patents exclusively for protective purposes, stating its policy, in an office memorandum, as follows:

In taking out patents we have three main purposes—

(a) To cover the actual machines which we are putting out, and prevent duplication of them.

* * * * *

(b) To block the development of machines which might be constructed by others for the same purpose as our machines, using alternative means.

* * * *

(c) To secure patents on possible improvements of competing machines, so as to "fence in" those and prevent their reaching an improved stage.

* * * *

We now have a number of applications which were filed to definitely forestall the development of competing machines by others. (Hearings, Temporary National Economic Committee, Investigation of Concentration of Economic Power, Part 2, *Patents*, pp. 776-777 (Exhibit No. 125).)

See also *United States v. Hartford-Empire Co.*, 46 F. Supp. 541, 611-612 (N. D. Ohio).

The head of the research division of a large industrial corporation testified before the Temporary National Economic Committee that:

Sometimes there are half a dozen ways of doing a thing after you start to do it. When you put your money on that way, you take out these auxiliary patents as sort of protective things you didn't find yourself * * *. (Hearings, Temporary National Economic Committee, Investigation of Concentration of Economic Power, Part 2, *Patents*, p. 345.)

Thus patents are often obtained and used aggressively not in exploitation of the patented device or process, not in "the public interest which is dominant in the patent system" (*Mercoïd Corp. v. Mid-Continent Co.*, 320 U. S. 661, 665), not "To promote the Progress of Science and useful Arts" (Const., Art. I, § 8), but, on the contrary, for the purpose of retarding and defeating related technological advances by others. While it does not appear that petitioner intends to use its patent monopoly on the subcombination as aggressively as was true in the *Ethyl* case, we submit that the constitutional and statutory purpose and the decisions of this Court frown equally on the passive use of a patent to protect something beyond its own scope.

Furthermore, petitioner's intention to use the subcombination patent for this purpose must be viewed not as something *sup. generis*, but as a mere example, though perhaps less dangerous than others, of an economic practice engaged in by many patentees contrary to public policy. The Court in considering the effect of issuing, on petitioner's subcombination, a patent which will be used to protect the monopoly of another patent, may well consider the full implications of such patents generally upon the national economy. See *Crosby Steam Gage & Valve Co. v. Manning, Maxwell & Moore, Inc.*, 51 F. Supp. 973,

974 (D. Mass.). The adverse effect of such a practice upon that economy is clear from the decisions of this Court and is confirmed by the hearings of the Temporary National Economic Committee referred to *supra*.

The constitutional concern for the interest of the public in the patent grant might not have suffered unduly in a slowly advancing technology by permitting the patent owner to use or not use his patent, as he alone saw fit, during the period of the patent grant, so long as the invention became available to the public at the end of that period. In today's technology, however, to require the public to await the patent owner's leisure or the end of the statutory period of the patent grant before use of the patent can be made, clearly flouts the public purpose underlying the constitutional directive. Such a requirement would mean that hundreds of patents, such as those held by Hartford-Empire and the General Electric Company, would never be brought into use, nor ever be dedicated to the public. For today "It is the rare invention which lives out its statutory period of protection and becomes common property before it is discarded." Temporary National Economic Committee, Monograph No. 31, *Patents and Free Enterprise*, p. 3. The *Hartford-Empire* case, *supra*, presents an imposing example of the type of monopoly that can be built of the skillful misuse, nonuse, and suppression of patents.

These considerations of public policy are not irrelevant here, nor solely for the Congressional car. The cases cited above have, for the most part, involved infringement suits or suits to enjoin violations of law. But analogous principles apply to any suit involving the aid of a court of equity. Suits brought under Revised Statutes, § 4915 (35 U. S. C. § 63), as was the suit at bar, are ordinary equity suits, subject to the usual rules, practices, and procedures of courts of equity. *Butterworth v. Hoe*, 112 U. S. 50, 61. Unlike the defendants in the *Hartford-Empire* case, petitioner is not complaining of the severity of a decree terminating antitrust violations at the behest of the Government. Rather, petitioner is seeking the aid of a court of equity to compel the Government to grant it an exclusive privilege in the form of a patent which the agency charged with this matter has denied; and petitioner acknowledges that it intends to use that privilege in a manner which, in our view, is at odds with the public interest. It is well established "that courts, and especially courts of equity, may appropriately withhold their aid where the plaintiff is using the right asserted contrary to the public interest. *Virginian Ry. Co. v. Federation*, 300 U. S. 515, 552; *Central Kentucky Co. v. Railroad Commission*, 290 U. S. 264, 270-73; *Harrisonville v. Dickey Clay Co.*, 289 U. S. 334, 337-38; *Beasley v. Texas & Pacific Ry. Co.*, 191 U. S. 492, 497; *Securities & Exchange*

Comm'n v. U. S. Realty Co., 310 U. S. 434, 455; *United States v. Morgan*, 307 U. S. 183, 194." *Morton Salt Co. v. Suppiger Co.*, 314 U. S. 488, 492. And in doing so they may, as did the court below, act *sua sponte*. *Mercoïd Corp. v. Mid-Continent Co.*, 320 U. S. 661, 670; *Beasley v. Texas & Pacific Railway Co.*, 191 U. S. 492, 498; *Renaud Sales Co. v. Davis*, 104 F. (2d) 683 (C. C. A. 1); *Gynex Corp. v. Dilex Institute of Feminine Hygiene, Inc.*, 85 F. (2d) 103 (C. C. A. 2).

Like principles justifying denial of equitable aid which could operate against public policy are reflected in *B. B. Chemical Co. v. Ellis*, 314 U. S. 495, and *Mercoïd Corp. v. Mid-Continent Co.*, 320 U. S. 661. In the case last cited, this Court held that entry of the decree sought would aid in expanding a patent "beyond its legitimate scope" and continued (at page 670):

But patentees and licensees cannot secure aid from the court to bring such an event to pass, "unless it is in accordance with policy to grant that help." *Beasley v. Texas & Pacific Ry. Co.*, 191 U. S. 492, 497. And the determination of that policy is not "at the mercy" of the parties (*id.*, p. 498) nor dependent on the usual rules governing the settlement of private litigation. "Courts of equity may, and frequently do, go much farther both to give and withhold relief in furtherance of the public interest

than they are accustomed to go when only private interests are involved." *Virginian Ry. Co. v. System Federation*, 300 U. S. 515, 552. "Where an important public interest would be prejudiced," the reasons for denying injunctive relief "may be compelling." *Harrisonville v. Dickey Clay Co.*, 289 U. S. 334, 338. And see *United States v. Morgan*, 307 U. S. 183, 194. That is the principle which has led this Court in the past to withhold aid from a patentee in suits for either direct or indirect infringement where the patent was being misused. *Morton Salt Co. v. G. S. Seppiger Co.*, *supra*, p. 492. That principle is controlling here.¹⁰

Although the basic right "secured by a patent consists only in the right to exclude others from making, using, or vending the thing patented without the permission of the patentee" (*United Shoe Machinery Corp. v. United States*, 258 U. S. 451, 463; *Bloomer v. McQuewan*, 14 How. 539), if a patent on the subcombination were issued to petitioner, it would be unable to enforce it since the only purpose a patent on petitioner's subcombination would serve would be the protection of the patent monopoly of petitioner's true invention—

¹⁰ The same principle has long been applicable in trademark infringement suits where the plaintiff, claiming infringement, has used his trade-mark or marketed his product in such a way as to defraud the public. *Worden v. Cal. Fig Syrup Co.*, 187 U. S. 516; *Renaud Sales Co. v. Davis*, 304 F. (2d) 683 (C. C. A. 1); *Gynex Corp. v. Dilex Institute of Feminine Hygiene, Inc.*, 85 F. (2d) 103 (C. C. A. 2).

the entire machine.¹¹ Granting the subcombination patent would make the Court a party to expansion of a patent "beyond its legitimate scope," and would in effect decree the vain and futile act of issuing an unenforceable patent—a position courts of equity traditionally refuse to take. See *Foster v. Mansfield Etc. R. Co.*, 146 U. S. 88, 101; *Hamilton-Brown Shoe Co. v. National Labor Relations Board*, 104 F. (2d) 49, 56 (C. C. A. 8); *In re Hawkins Mortg. Co.*, 45 F. (2d) 937 (C. C. A. 7); *Sain v. Mont. Power Co.*, 20 F. Supp. 843 (D. Mont.); cf. *Gaskins v. Bonfils*, 8 F. Supp. 832, 837 (D. Colo.).¹² It was sound, therefore, for

¹¹ See cases cited pp. 22-23, *supra*.

¹² Applicants for patents may, in some cases, urge the difficulty of predetermining whether a court in an infringement suit will hold the "invention" to reside in an entire combination or in improvements made in subsidiary parts thereof. However, in this case the applicant, petitioner's assignor, by the method of prosecuting his case, adopted the position that the "invention" lies in the entire machine and petitioner has accordingly asserted that the subcombination claims are included solely to protect the combination covered by the allowed claims. Even if the applicant were deemed entitled to present claims in the two forms in order to anticipate possible differences of opinion as to the proper mode of claiming the invention, he should have pursued this course fully in prosecuting his original application. This he did not do. Instead, by failing to seek review of the decision of the Board of Appeals denying the subcombination claim in the original application (see p. 3, fn. 1, *supra*), the applicant acquiesced in that decision and allowed it to stand. Accordingly, peti-

the court below to have declined its aid to compel issuance of a patent which, *in limine*, was intended to be suppressed in order to aid another patent.

II

THE SUBCOMBINATION CLAIMS WERE PROPERLY REJECTED AS INCOMPLETE, TOO BROAD, AND MISLEADING

Section 4888 of the Revised Statutes (35 U. S. C. § 33), requires an applicant for a patent to file a written description of his invention "in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains * * * to make, construct, compound, and use the same * * *." This condition, required by Congress "for the protection of the public, * * * must be satisfied before the monopoly is granted." *General Electric Co. v. Wabash Co.*, 304 U. S. 364, 372.

tioner is not entitled to reassert the subcombination claims in this, a renewal case. See pp. 43-46, *infra*.

It is not material that the terminology of the present subcombination claims differs somewhat from that of the subcombination claim in whose rejection its assignor acquiesced during the prosecution of the original application. The Patent Office and the courts have held that such difference is not one of substance and the effect of the acquiescence in the original Board of Appeals ruling is not avoided thereby. Even if the present subcombination claims were held to be different in substance from the original subcombination, however, since the original subcombination claim was not allowed, the present subcombination claims may not be prosecuted in a renewal application. See pp. 43-46, *infra*.

The District Court upheld the rejection of the disputed claims by the Patent Office on the grounds that the splitting knife is an essential element of the combination, the machine without it was not the invention disclosed in the application, and, since the rejected claims do not accurately describe the invention, they are not a true sub-combination (R. 9-10). Such findings of a District Court are not to be set aside unless shown to be clearly wrong (Rule 52 (a), F. R. C. P.; *Adamson v. Gilliland*, 242 U. S. 350; *Warren v. Keep*, 155 U. S. 265; *General Motors Corp. v. Coe*, 120 F. (2d) 736 (App. D. C.), certiorari denied, 314 U. S. 688, rehearing denied, 314 U. S. 715; *Hydraulic Press Corp. v. Coe*, 134 F. (2d) 49 (App. D. C.). The burden of showing such findings to be clear error is augmented where, as here, they concur with those of the Patent Office (R. 9-10, 131-132, 134-135). *Abbott v. Coe*, 109 F. (2d) 449 (App. D. C.).¹³ It is equally well settled that findings such as those made here were ample to uphold rejection of the claims in question. *General Electric Co. v. Wabash Co.*, 304 U. S. 364, 368, 372; *Schriber Co. v. Cleveland Trust Co.*, 305 U. S. 47, 56-57; *Goodman v. Super Mold Corp.*,

¹³ Compare the two-court rule frequently enunciated by this Court. See *Baumgartner v. United States*, 322 U. S. 665; *Goodyear Tire & Rubber Co., Inc. v. Ray-O-Vac Co.*, 321 U. S. 275, 278; *Virginian Ry. v. System Federation*, 300 U. S. 515, 542; *United States v. Commercial Credit Co., Inc.*, 286 U. S. 63, 67.

103 F. (2d) 474 (C. C. A. 9); *Rodman Chemical Co. v. Deeds Commercial Laboratories*, 261 Fed. 189 (C. C. A. 7); *Loggie v. Puget Sound Mills and Timber Company*, 194 Fed. 158 (W. D. Wash.); see also *Ideal Roller and Manufacturing Co. v. Sutherland Paper Co.*, 96 F. (2d) 675, 677 (C. C. A. 6).

Far from being clearly wrong, the findings of the district court find ample support in the evidence. The record shows that while the splitting device can be eliminated from the machine without interfering with the other operations of bobbing, peeling, and coring, to do so would involve pre-splitting the pears, holding the halves together face to face, and carefully and accurately placing them together in the machine (R. 20, 27). Splitting pears before bobbing them is a practice which, for obvious reasons, has never been commercially adopted, whether these operations were performed by hand or by machine (R. 16, 24). Indeed, the labor requirements for petitioner's machine are doubled when the cutting device is removed therefrom (R. 18, 26). And although petitioner's machine has been in use in canneries since 1931 (R. 15), it was not until 1941 or 1942 that pre-split pears were first put into a bobbing machine, and then it "was tried out" only at the suggestion of petitioner's attorney (R. 23-25).¹⁴ The verdict of petitioner's own witness was that use of the

¹⁴ See fn. 4, *supra*.

machine minus the splitting device was "a disadvantageous method" of preparing pears (R. 25).

The rejected claims, covering the partial machine, imply that the machine described by them operates upon whole pears, whereas, in fact, it is only the bobbing device that can so act, since the peeling and coring device is "intended and adapted for paring and coring split pears and could not be used for paring and coring whole pears" (R. 135). The evidence does show, as stated above, that the partial machine can be operated without the splitting device, albeit disadvantageously and contrary to sound commercial practice, by splitting the pears before placing them in the machine. But the ability to use the subcombination in this way is not disclosed by the rejected claims. As the Board of Appeals stated (R. 134-135):

The entire disclosure relates to the preparation of the pears by starting with whole pears. The holding means on the first turret are so shaped that they fit whole pears and hold them firmly while they are being operated on. A number of parts are so shaped that they are specially adapted to handle or operate on whole pears. The timing of the parts is such that the cutter comes into operation at a certain time during the preparation of the pears in the machine. The parts in the second turret are intended and adapted for paring and coring split pears and could not be used

for paring and coring whole pears. It seems to us that the pear-splitting mechanism is an essential part of the machine and the entire machine was constructed with a view of starting with whole pears and splitting them.

While the court below characterized the ground of decision in the district court as resting "on a very slender foundation" (R. 142), it did not hold that the evidence was inadequate to support the view of the Patent Office and the district court. On the contrary, the main opinion below adverted to the fact that the partial machine "is not designed" for use without the cutting knife, that "it is only an artificial and clumsy substitute for the complete machine," and that "there is no rhyme or reason for manufacturing such a partial machine when there is available the complete machine which does the cutting mechanically" (R. 143). Justice Miller, who filed a separate concurring opinion (R. 148-152) in which the other two justices also concurred (R. 148, 152), indicated his disagreement with the findings of the district court (R. 148), but nevertheless approved and adopted the finding of the Board of Appeals of the Patent Office to substantially the same effect—"that the claims as drawn * * * cover constructions never contemplated by applicant" (R. 148). And the concurring Justice found that when the partial machine is compared with the complete machine, "its utility is lessened, to say the least;

and the subcombination claims become suspect" (R. 152).

In these circumstances, the statutory requirement of a "full, clear, concise, and exact" description of the invention (R. S. 4888) has clearly not been satisfied by either the petitioner or its assignor. The rejected claims disclose a machine which purports to operate upon whole pears when, in fact, the coring and peeling device cannot so operate (R. 134-135); and the claims in question fail to disclose the means by which the coring and peeling device in the partial machine can be made to operate upon pears, that is, by pre-splitting. The mere fact that the subcombination can be used does not justify the allowance of subcombination claims which do not disclose, as required by the statute, how that use may be made. *Abbott v. Coe*, 109 F. (2d) 449 (App. D. C.).

To the extent that the rejected claims refer to a machine which operates upon pears generally, rather than upon half pears, they are both broader than the invention and misleading in omitting an element essential to make the machine operable (either a splitting device such as is contained in the complete machine, or some mechanical or manual pre-splitting device). Failing to meet the statutory standard, such claims were properly rejected by the Patent Office. *Goodman v. Super Moid Corp.*, 103 F. (2d) 474 (C. C. A. 9); *Rodman Chemical Co. v. Deeds Commercial Labora-*

tories, 261 Fed. 189 (C. C. A. 7); *Loggie v. Puget Sound Mills and Timber Company*, 194 Fed. 158 (W. D. Wash.); see also *Ideal Roller and Manufacturing Co. v. Sutherland Paper Co.*, 96 F. (2d) 675, 677 (C. C. A. 6).

III

THE SUBCOMBINATION CLAIMS MUST BE REJECTED AS NOT PROPERLY WITHIN THE SCOPE OF THE RENEWAL APPLICATION

On October 27, 1938, the Patent Office advised petitioner's assignor that his application for a patent had been examined and allowed with 11 claims, and that a patent thereon would be issued upon payment of the final fee within 6 months (R. 2, 124-125). The claims thus allowed were directed to the entire machine, including the splitting means, and not to the subcombination here involved (R. 132, 134).

On October 26, 1939, the petitioner's assignor, not having paid the required fee within 6 months of the notice of allowance, referred to the allowance of October 27, 1938, and filed a renewal application "for said invention" (R. 125). He did this pursuant to Revised Statutes § 4897, which, as amended by the Act of March 2, 1927, c. 273, § 2, 44 Stat. 1335, provided:

Any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of

the final fee, but who fails to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application. But such second application must be made within one year after the allowance of the original application. * * * ¹⁸

and pursuant to Patent Office Rule 175, 37 C. F. R. 1.175, which provided:

When the patent has been withheld by reason of nonpayment of the final fee, any person, whether inventor or assignee, who has an interest in the invention for which the patent was ordered to issue may file a renewal of the application for the same invention; such renewal of the application may be filed any time after the case is allowed * * * But any renewal ap-

¹⁸ R. S. § 4897 was repealed by the Act of August 9, 1939, c. 619, § 1, 53 Stat. 1293, before the renewal application here involved was filed. But that Act contained a saving clause, § 4, providing "That in all cases in which the notice of allowance had been sent prior to the time at which this Act takes effect the final fee may be paid and other proceedings may be taken under the statutes in force at the time of approval of this Act as if such statutes had not been amended or repealed." Accordingly, since the notice of allowance had been sent prior to the Act of August 9, 1939, the renewal provision of R. S. § 4897, despite its repeal by that Act, remained applicable to this proceeding.

plication must be made within 1 year after the allowance of the original application.¹⁶

The statute and rule pertinent to renewal applications thus permitted such an application to be made only for the invention for which a patent had been ordered to issue. This clear statutory limitation was recognized by petitioner's assignor in his renewal application (R. 125). Despite the statutory limitation, however, restricting the renewal application to the same invention as was originally allowed, petitioner introduced with the renewal application the subcombination claims here in issue, similar to the subcombination claim in whose previous disallowance petitioner had acquiesced (R. 132; p. 3, fn. 1, *supra*). A machine which only bobs, cores, and peels pre-split pears can hardly be considered the "same invention" as the machine which bobs and splits *whole* pears and then cores and peels the half-pears. And, since the invention for which the patent was ordered to issue on October 27, 1938, upon payment of the final fee, consisted of a machine which performed the latter operations (R. 2, 124, 132, 134), the invention, if any, covered by the disputed claims included in the renewal application is certainly not "such invention" as had been allowed.

¹⁶ This rule was amended on September 28, 1939, but only "with respect to applications in which the notice of allowance was not sent before August 9, 1939." 4 F. R. 4057. The amendment was therefore inapplicable to petitioner's case.

In similar circumstances it has been held that when the claims allowed in the original application are directed to one combination or subcombination of elements, the renewal cannot be allowed to embrace claims to a different combination or subcombination. *In re Kaisling*, 44 F. (2d) 863 (C. C. P. A.). Since the partial machine covered by the claims here in issue consists of a different combination of elements from that covered by the claims originally allowed, the claims in dispute could not have been allowed on the renewal application. This constituted an independent basis for upholding the action of the Patent Office in rejecting ^{the} claims.

CONCLUSION

For the reasons stated, we respectfully submit that the judgment should be affirmed.

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FEBRUARY 1945.



APPENDIX

Section 4884 of the Revised Statutes (35 U. S. C. § 40) provides:

Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery (including in the case of a plant patent the exclusive right to asexually reproduce the plant) throughout the United States and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

Section 4883 of the Revised Statutes (35 U. S. C. § 31) provides:

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for

more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor.

Section 4888 of the Revised Statutes (35 U. S. C. § 33) provides in part:

Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor * * *

Section 4897 of the Revised Statutes (35 U. S. C. § 38) provided in part:

Any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who fails to make payment thereof within six months from the time at which it was passed and allowed.

and notice thereof was sent to the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application. But such second application must be made within one year after the allowance of the original application. * * *

The Act of August 9, 1939, c. 619, 53 Stat. 1293, provides in part:

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section 4897 of the Revised Statutes (U. S. C., title 35, sec. 38) be repealed.

* * * * *

SEC. 4. This Act shall take effect upon approval: *Provided, however,* That in all cases in which the notice of allowance had been sent prior to the time at which this Act takes effect the final fee may be paid and other proceedings may be taken under the statutes in force at the time of approval of this Act as if such statutes had not been amended or repealed.

Section 4915 of the Revised Statutes (35 U. S. C. § 63) provides:

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such

refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

SUPREME COURT OF THE UNITED STATES.

No. 469.—OCTOBER TERM, 1944.

Special Equipment Company,
Petitioner,
vs.
Conway P. Coe, Commissioner of
Patents.

On Writ of Certiorari to
the United States Court of
Appeals for the District
of Columbia.

[March 26, 1945.]

Mr. Chief Justice STONE delivered the opinion of the Court.

This is a suit in equity, brought in the District Court of the District of Columbia, under R. S. § 4915, to compel respondent, the Commissioner of Patents, to issue a patent upon an application for a subcombination of the elements of a machine for which the inventor had previously filed a patent application. The district court gave judgment for respondent. The Court of Appeals for the District affirmed, 144 F. 2d 497, and we granted certiorari, 323 U. S. —. The question is whether the Court of Appeals correctly rested its decision upon the ground that petitioner did not intend to make or use the ~~patented~~ invention and that the purpose of seeking the patent was to exploit and protect the combination invention embodied in the complete machine, of which the subcombination is a part.

Ewald, the plaintiff in the district court in whose stead petitioner, his assignee, was later substituted as a party, made application for a patent on a "fruit-treating apparatus" embracing the combination embodied in his complete machine. Certain claims of his application were allowed October 27, 1938, but a patent has not yet issued. The following year he made a renewed application for the subcombination, with which the present suit is concerned. The specifications of the original application disclosed mechanisms for automatically performing the successive operations of bobbing (cutting off the stems), splitting, paring, and coring pears, in preparation for canning or other processing.

The original application specified and claimed an apparatus consisting of two spaced, horizontally mounted turrets or turn tables, combined with means for continuously, but intermittently,

rotating both in the same direction. Fixed upon, and rotatable with the table of the first turret, are a plurality of pear receiving and clamping means, spaced upon the upper surface of the turn table, adapted to receive and clamp either a pre-split or a whole pear. At the first intermittent stop a swinging knife shears off (bobs) the stem of the fruit, which extends beyond the clamps. At the next intermittent stop, overhead traveling jaws or clamps grasp the fruit concurrently with its release from the first clamp and carry the fruit longitudinally to a point over the second turn table.

As the pear is thus carried from the first turret to a position over the second, it is split by a fixed vertically positioned knife straddled by the overhead traveling clamps. As the clamps force the pear against and past the knife, it cleaves the pear into substantially equal half sections. The pear sections are then automatically, successively deposited in spaced cups fixed on the second revolving turn table. At the next stop of that turn table the pear section resting in its cup is peeled by an automatically operated paring knife. At the next successive stop the core is removed from the pear section by an automatically operated coring device. After completing the coring, the mechanism automatically separates the pear section from the core and the peeling and discharges them and the pear section into appropriate receptacles.

In the operation of the machine whole or split pears may be fed by hand to the holding and clamping devices on the first turret where the pears are bobbed. The whole pear is then split as it is carried by the overhanging jaws from the first turret to the second. The peeling and coring of both pre-split and whole pears are then carried through by the operation of the second turret.

The patent application for the complete machine discloses a highly ingenious device, which is said to have achieved a great advance in the art by increasing the speed and skill with which pears are prepared for canning, and to result in a great saving of manpower. The renewed application for the subcombination specifies and claims the apparatus which we have described but without the splitting knife. In the operation of the device thus claimed the pears are pre-split by hand. The split sections are placed face to face in the receiving and clamping means upon the first turn table, after which the operation, except the splitting by the split-

ting knife, proceeds in exactly the same way and accomplishes the same result as when the splitting knife is present.

Additional claims, which are those sued on, covering all the elements of the combination except the splitting knife, were duly presented to the Patent Office. There they were rejected as incomplete, broader than the invention disclosed by the petitioner in his application, and misleading, and as covering constructions not contemplated by petitioner's application. Respondent Commissioner, alleging no prior art against the allowance of the claims, set up these objections in his answer in the district court as the sole grounds of defense to the suit. The district court sustained the Commissioner on the grounds assigned by him for rejection of the claims, and for the further reason that the subcombination claims did not "combine to produce any useful result".

The Court of Appeals, after observing the operation of petitioner's subcombination without the cutting knife, as shown by moving pictures, concluded that the device was far more useful in its operation than the old method of preparing fruit by hand, and, without deciding the point, added that it was plausible to say "that two distinct inventions are disclosed in the application".

Without further examination of the issues raised by the pleadings it affirmed the judgment of the district court upon the new and independent ground that a patent on the subcombination should not be granted because of "the dangers of approving a principle which permits a patent monopoly to be extended by granting claims on distinct inventions, which the applicant has no intention of exploiting as distinct inventions". It said: "The record shows that it [the subcombination patent] is to be used to exploit and protect the patent monopoly of another related invention, to-wit: the complete machine. There is no intention to make or license to others to make the partial machine because, although it is possible to use it without the cutting knife, it is not designed for such independent use." It thought that the grant of a patent which the patentee has no intention of exploiting as a distinct invention "for the purpose of blocking the development of machines which might be constructed by others", is inconsistent with the constitutional requirement that the patent grant must "promote the Progress of Science and useful Arts".

We are pointed to no factual basis in the record for the assertion that petitioner contemplates either the misuse or non-use of the combination patent other than that suggested in the court's

opinion that the complete machine does the work better than the subcombination, without the knife, can do it and that there would be no reason to manufacture the partial machine when the complete machine was available. A separate opinion in which all the judges concurred also states that petitioner "admitted, both on argument and in his brief in the present case, that its purpose in filing the disputed claims was to 'protect' the main invention and that it had no intention of manufacturing the subcombination machine". The reference, as agreed by counsel on the argument before us, is to a statement in petitioner's brief in the court below that: "The claims in issue are sought purely to prevent appropriation of the . . . machine by the obvious expedient of eliminating the splitting mechanism". It will be observed that this statement of petitioner is not of a purpose either to suppress the use of the patented invention or to use it or the patent to exploit or enlarge the patent monopoly of the complete machine.

The court below found support for its conclusion in our decisions holding that a patentee may not enlarge the monopoly of his patent by licensing his invention on terms or conditions which tie to its use the use of material or devices which the licensed invention does not embrace, whether they are patented, *Ethyl Gasoline Corp. v. United States*, 309 U. S. 436, 459; *Standard Sanitary Mfg. Co. v. United States*, 226 U. S. 20, or unpatented. *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U. S. 502; *United Shoe Machinery Co. v. United States*, 258 U. S. 451; *Carbice Corporation v. American Patents Corp.*, 283 U. S. 27; *Leitch Manufacturing Co. v. Barber Co.*, 302 U. S. 458.

It is clear that no such case is presented here. We find nothing in the statement quoted from petitioner's brief in the court below or in the record to indicate that petitioner proposes to make any such use of the patent which it now seeks, either by the method of licensing it or otherwise. The statement expresses only a purpose to prevent appropriation of the complete machine by the appropriation of a part of it embodied in the subcombination for which the patent is asked. There is nothing to suggest any purpose or reason for a purpose to enlarge the monopoly either of the subcombination or of the complete machine by tying together their uses. Control of a part could not be used as a means of enlarging an already acquired control of the whole.

And obviously licensing the subcombination, which is less useful than the whole, would not, in any circumstances disclosed by the record, be a practical means of enlarging the use of the whole. Failure to acquire control of the whole would be a legitimate reason for wishing to acquire and retain control of a part, if it involves a patentable invention. And we think it plainly is legitimate to use a patent on the subcombination as a means of preventing appropriation by others of petitioner's more important complete invention which he is using, where there is absent, as there is here, any purpose to enlarge the monopoly of either invention.

A patent on the combination embodied in the complete machine, without the allowance of the subcombination claims, would not, as the court below thought, prevent the free use of the subcombination. *The Corn-Planter Patent*, 23 Wall. 181, 224; *Schumacher v. Cornell*, 96 U. S. 549, 554; *Rowell v. Lindsay*, 113 U. S. 97, 101; *Mercoird Corp. v. Mid-Continent Co.*, 320 U. S. 661, 668. Hence denial of a patent on the subcombination would deprive the inventor of the benefit of the exclusive right to use the subcombination in the ways specified by the patent laws. It would also leave the public free to use, and thus to appropriate a part, however important, of the inventor's complete machine, even though patented.

If, as we must assume, petitioner has two inventions, both of which are useful and one of which includes the other in its entirety, it is evident that the value of the former would be greatly impaired if the subcombination invention could be freely used by others. See *Deering v. Winona Harvester Works*, 155 U. S. 286, 302. But such appropriation or impairment of the value of the full combination could be achieved only by appropriation of the unpatented subcombination which is by hypothesis also a useful invention, entitled to claim the benefit and protection of the patent laws.

The statutes permit, and it is the settled practice of the Patent Office, many times sustained by this Court, to allow claims to a combination and also its subcombinations. *Railroad Co. v. DuBois*, 12 Wall. 47, 60; *Deering v. Winona Harvester Works*, *supra*; *Leeds & Catlin v. Victor Talking Mach. Co.*, 213 U. S. 391, 318; *Altoona Theatres v. Tri-Ergon Corp.*, 294 U. S. 477, 487; *Mercoird Corp. v. Mid-Continent Co.*, *supra*, 667. The question then

is whether without more, the use of the subcombination patent to prevent appropriation of the complete machine so infringes any provisions or principles of the patent laws, or is so contrary to principles governing the award of equitable relief as to permit the court to refuse the judgment, which the statute authorizes, directing that the patent issue.

In answering it the court below assumed that such purpose to protect the whole invention was to be achieved by complete suppression of the use of the subcombination invention and that the suppression for the protection of the complete machine would invalidate the patent because it would be contrary to the constitutional purpose and to the spirit if not the letter of the patent laws. We think both assumptions are unwarranted. Section 4886 of the Revised Statutes authorizes "any person who has invented . . . any new and useful . . . machine" to "obtain a patent". The patent grant is not of a right to the patentee to use the invention, for that he already possesses. It is a grant of the right to exclude others from using it. As the statute, R. S. § 4884 provides, the grant is of the "exclusive right to make, use and vend" the invention, and this includes the exclusive right to license others to make, use and vend it. By the very terms of the statute the grant is nothing more than a means of preventing others, except under license from the patentee, from appropriating his invention.

It by no means follows that such a grant is an inconsistent or inappropriate exercise of the constitutional authority of Congress "to promote the Progress of Science and useful Arts" by securing to inventors "the exclusive Right to their . . . Discoveries". Congress, in the choice of means of promoting the useful arts by patent grants, could have provided that the grant should be conditioned upon the use of the patented invention, as in fact it did provide by the Act of 1832 (4 Stat. 577) authorizing the issue of patents to aliens conditioned upon the use of the invention, which provision was later repealed (5 Stat. 117, 125). But Congress was aware that an unpatented invention could be suppressed and the public thus deprived of all knowledge or benefit of it. It could have concluded that the useful arts would be best promoted by compliance with the conditions of the statutes which it did enact, which require that patents be granted only for a limited term upon an application fully disclosing the invention

and the manner of making and using it. It thus gave to the inventor limited opportunity to gather material rewards for his invention and secured to the public the benefits of full knowledge of the invention and the right to use it upon the expiration of the patent.

This Court has consistently held that failure of the patentee to make use of a patented invention does not affect the validity of the patent. *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405; *Crown Co. v. Nye Tool Works*, 261 U. S. 24, 34; *Woodbridge v. United States*, 263 U. S. 50, 55; *Fox Film Corp. v. Doyal*, 286 U. S. 123, 127; *Hartford-Empire Co v. United States*, 323 U. S. 386, 433. No question of non-use was involved in *Ethyl Gasoline Corporation v. United States*, *supra*, 459, on which the court below relied, and it lends no support to the contention that a patentee may not rightly use his patent as a protection against misappropriation of his invention, even though it is not used. There it was held only that the monopoly of a patent afforded no defense for violations of the Sherman Act which the patentee had effected by using his patent to enlarge the patent monopoly beyond the grant and as a means of increasing the use of an independent patented invention.

Congress has frequently been asked to change the policy of the statutes as interpreted by this Court by imposing a forfeiture¹ or providing for compulsory licensing² if the patent is not used within a specified time, but has not done so.

We have no occasion to consider here whether a better rule governing the grant of patents could be devised than that prescribed by Congress, as this Court has interpreted it; or whether the courts on equitable principles should decline to enjoin patent infringements or decline to compel the issue of a patent if and when it appears that the patentee or inventor intends to make no use of the invention. The record neither calls upon nor permits us to decide any of these questions, for it fails to establish that petitioner has any such intention. Petitioner's intended use of the patent to prevent others from appropriating it and by that means from appropriating an essential part of his complete machine is in no way inconsistent with petitioner's making other

¹ See *Hartford-Empire Co. v. United States*, *supra*, 433, n. 26.

² See *Hartford-Empire Co. v. United States*, *supra*, n. 27.

permissible uses of the subcombination patent. In fact, he does use the subcombination as a part of his completed machine and proposes to continue to use it. Execution of his declared purpose to prevent appropriation of either of his inventions, whether used separately or together, would not prevent his licensing others to make, use and vend the subcombination, on terms which would adequately protect the value of the monopoly of both his inventions to which he is entitled by the patent laws. And we cannot say that others, who could not secure a license to use the complete machine, would not find it profitable to secure, or that petitioner would not find it profitable to grant, licenses to use the subcombination which the court below has found to be a useful device which has advanced the art.

The record establishes no intention by petitioner not to use his invention, and no proposed use of it disclosed or suggested by the record affords any basis for withholding the grant of the patent. The judgment below must therefore be reversed, and the cause remanded to the Court of Appeals for further proceedings in conformity to this opinion to enable it to consider and decide the issues raised by the pleadings. See *Bates v. United States*, 323 U. S. 15, 17 and cases cited.

Reversed.

Mr. Justice DOUGLAS, with whom Mr. Justice BLACK and Mr. Justice MURPHY concur, dissenting.

The right of suppression of a patent came into the law over a century after the first patent act was passed. In 1886 Judge Blodgett had ruled that a patentee "is bound either to use the patent himself or allow others to use it on reasonable or equitable terms." *Hoe v. Knap*, 27 Fed. 204, 212. In 1896 that rule was repudiated by the Circuit Court of Appeals for the Sixth Circuit in *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288, 295, where the court stated that a patentee's "title is exclusive, and so clearly within the constitutional provisions in respect of private property that he is neither bound to use his discovery himself, nor permit others to use it." That theory was adopted by this Court in *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405, decided in 1908. That was an infringement suit. One defense was that the patentee had

suppressed the patent. The Court held, Mr. Justice Harlan dissenting, that suppression of the patent was no defense; that the patentee's "right can only retain its attribute of exclusiveness by a prevention of its violation." *Id.*, p. 430.

I think it is time to be rid of that rule. It is inconsistent with the Constitution and the patent legislation which Congress has enacted.

Article I, Section 8 of the Constitution grants Congress the power "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." Of the various enumerated powers it is the only one which states the purpose of the authority granted Congress. "The Congress is given no general power to issue letters patent or to reward inventors as it will. An experience with grants of monopoly in England was fresh in the minds of the Fathers; the lesson had been underlined in recent differences with the Crown." Hamilton, *Patents and Free Enterprise* (1941), p. 152, Temporary National Economic Committee, Monograph No. 31, 76th Cong., 3d Sess. The purpose "to promote the progress of science and useful arts" accordingly provides the standards for the exercise of the power and sets the limits beyond which it may not go. That purpose also provides the guide for the interpretation of patent laws enacted pursuant to that power.

It is a mistake therefore to conceive of a patent as but another form of private property. The patent is a privilege "conditioned by a public purpose." *Mercoind Corp. v. Mid-Continent Co.*, 320 U. S. 661, 666. The public purpose is "to promote the progress of science and useful arts." The exclusive right of the inventor is but the means to that end. That was early recognized by this Court. See *Pennock v. Dialogue*, 2 Pet. 1, 19; *Kendall v. Winsor*, 21 How. 322, 327-328; *Seymour v. Osborne*, 11 Wall. 516, 533-534. But the *Paper Bag* case marked a radical departure from that theory. It treated the "exclusive" right of the inventor as something akin to an "absolute" right. It subordinated the public purpose of the grant to the self-interest of the patentee.

The result is that suppression of patents has become commonplace. Patents are multiplied to protect an economic barony or

empire, not to put new discoveries to use for the common good.¹ "It is common practice to make an invention and to secure a patent to block off a competitor's progress. By studying his ware and developing an improvement upon it, a concern may 'fence in' its rival; by a series of such moves, it may pin the trade enemy within a technology which rapidly becomes obsolete. As often as not such maneuvers retard, rather than promote, the progress of the useful arts. Invariably their effect is to enlarge and to prolong personal privilege within the public domain." Hamilton, *op. cit.*, *supra*, p. 161. One patent is used merely to protect another. The use of a new patent is suppressed so as to preclude experimentation which might result in further invention by competitors.² A whole technology is blocked off. The result is a clog to our economic machine and a barrier to an economy of abundance.

It is difficult to see how that use of patents can be reconciled with the purpose of the Constitution "to promote the progress of science and the useful arts." Can the suppression of patents which arrests the progress of technology be said to promote that progress? It is likewise difficult to see how suppression of patents can be reconciled with the provision of the statute which authorizes a grant of the "exclusive right to make, use, and vend the invention or discovery." Rev. Stat. § 4884, 35 U. S. C. § 40. How may the words "to make, use, and vend" be read to mean "not to make, not to use, and not to vend"? Take the case of an invention or discovery which unlocks the doors of science and reveals the secrets of a dread disease. Is it possible that a patentee could be permitted to suppress that invention for seventeen years (the term of the letters patent) and withhold from humanity the benefits of the cure? But there is no difference in principle between that case and any case where a patent is suppressed because of some immediate advantage to the patentee.

I think it is time to return to the earlier, and I think the true, philosophy of the patent system. We should not pass on to Con-

¹ For illustrations see Investigation of Concentration of Economic Power, Hearings, Temporary National Economic Committee, Pt. 2 (1939), pp. 345, 776; Hamilton, *op. cit.*, *supra*, pp. 46-47, 59.

² The vice is the same as the practice, consistently condemned by this Court, of writing into the claims broad, general specifications. As stated by Mr. Justice Bradley in *Carlton v. Bokee*, 17 Wall. 463, 471-472, "We think it proper to reiterate our disapprobation of these ingenious attempts to expand a simple invention of a distinct device into an all-embracing claim, calculated by its wide generalizations and ambiguous language to discourage further invention in the same department of industry . . ."

gress the duty to remove the private perquisites which we have engrafted on the patent laws. This Court was responsible for their creation. This Court should take the responsibility for their removal. I would adopt the view of *Hoe v. Knap*, *supra*. In a case like the present (*Butterworth v. Hoe*, 112 U. S. 50, 61), as in infringement suits (*Morton Salt Co. v. Suppiger Co.*, 314 U. S. 488, 492-494) the Court sits as a court of equity. It should withhold its aid from a patentee who has employed or plans to employ the patent not to exploit the invention but to suppress it in order to protect another patent or otherwise.³ Cf. *Ethyl Gasoline Co. v. United States*, 309 U. S. 436, 459. If that purpose were clear, a patent should not issue in the first instance. If it has been issued and not cancelled and the patent has been suppressed, any one should be permitted to use it at least on payment of reasonable royalties. In that way the constitutional objective will be more nearly realized—the product of the inventive genius of the human mind will be put to work in the economy.

³ These situations are to be distinguished from the case of the inventor who though he has an expectation of exploiting the patent has not yet arranged the necessary financing, or, for other reasons, has not yet been able to go into production.

Mr. Justice RUTLEDGE, dissenting.

I would affirm the judgment. But I do not reach the interesting and important questions debated by the Court's opinion and my dissenting brethren. They are of such a character that, in my opinion, they should not be determined in the absence of a record presenting facts and issues making this necessary. In this case the facts do not so clearly present the issues of "fencing" and "blocking" that decision upon them is required or appropriate.

Those issues were not raised or considered until the case reached the Court of Appeals. Evidence concerning intent to suppress was not received in the District Court and petitioner is entitled to its day in court upon that question, unless it has conceded it. The record, as this Court's opinion indicates, is not clear that the concession has been made with the effect of admitting that petitioner had no intention to exploit the patent. If, as the trial court found, the machine without the splitting knife would not "produce any useful result," this fact together with the assertion

of the claims relating to the full combination, or with it and the concessions apparently made in the Court of Appeals, might be sufficient to sustain that court's conclusion that the only purpose of the alleged invention was to "fence" or "block." But the Court of Appeals expressly rejected the trial court's finding in this respect and a showing of motion pictures here, such as took place in the Court of Appeals, appeared to demonstrate conclusively that the machine not only works without the cutting knife, but produces a highly useful result if the pears are split before being placed in the machine for bobbing, peeling and coring. Whatever foundation might have been found, therefore, to support the conclusion of intent to fence or block, in the machine's lack of capacity to produce any useful result, disappears from the case.

The record, however, discloses another ground which was considered in the Patent Office and the District Court, wholly sufficient to dispose of the case and requiring affirmance of the judgment. This was that the claims in issue are too broad to cover the invention. No one of the claims specifies or indicates that the pears must be pre-split in order for the invention to be used or to produce a useful result. With commendable candor, counsel conceded this in the argument here, and indeed the claims on their face require the concession. Patents are not to be granted upon claims which do not accurately describe the invention and all of its essential features. These claims are stated in language broad enough to include whole pears. Admittedly the machine will not work, without the knife, as to them. In my judgment therefore the claims are too broad. The Patent Office and the District Court so found. The question is open and was presented in the Court of Appeals and here. Accordingly I would affirm the judgment.